

REMARKS/ARGUMENTS

In response to the Office Action mailed April 27, 2005, Applicant requests reconsideration. In this Amendment, no claims are cancelled and claims 45-48 are added so that claims 1-48 are now pending.

What is The Basis of Rejection of Claim 16?

In reply to the comments concerning the lack of clarity of the rejections, the Examiner made an attempt to clarify the prior art rejections. This attempt was not entirely successful. In the previous response, Applicant requested a clarification as to the basis of the rejection of claim 16, an independent claim directed to the safe. That explanation was not provided and the inconsistency in the rejection remains. To explain, claim 16 remains rejected as obvious over some combination of patents whereas its dependent claims 17-20 remain rejected as anticipated by one of the principal references. Dependent claims cannot be rejected as anticipated by a single reference unless their parent claim is likewise rejected. Again, Applicant respectfully requests clarification and assumes that claims 16-20 are all rejected as obvious and that none of those claims is rejected as anticipated.

The Office Action includes no clear rejection of claims 39-42. Those claims are analogous, in a way, to claims 17-20, claims that seem to be rejected as anticipated yet depend from a claim rejected as obvious. It is presumed that the rejection of claims 39-42 is the same as the rejection of claims 17-20, whatever the rejection of claims 17-20 may be.

Likewise, the following rejections are inconsistent, the rejections of claims 10 and 11, the rejection of claims 32 and 33, the rejections of claims 35 and 36, and the rejections of claims 43 and 44 versus claim 38. Because of the confusion, Applicant's representative sets forth below the rejections that it is presumed were intended to be made. In view of the omission of rejection of any of claims 39-42, and the inconsistencies in the rejections, any further Office Action that is not an allowance cannot properly be a final rejection because the Office Action of April 27, 2005 is incomplete.

The Rejections as Best Understood

Claims 1-5, 7, 8, 23-27, 29, and 30 are rejected as anticipated by Heidel et al. (U.S. Patent 6,289,261, hereinafter Heidel).

Claims 6, 9, 10, 12, 13, 21, 22, 28, 31, 32, 34, 35, 43, and 44 are rejected as unpatentable over Heidel in view of Tillim et al. (U.S. Patent 6,065,408, hereinafter Tillim)..

Claims 15 and 37 are rejected as unpatentable over Heidel in view of Kaish et al. (U.S. Patent 5,997,928, hereinafter Kaish).

Claims 16-20 and 38-42 are rejected as unpatentable over Heidel in view of Kaish and further in view of Martin et al. (U.S. Patent 6,520,308, hereinafter Martin).

Claims 43 and 44 are rejected as unpatentable over Heidel in view of Kaish, further in view of Martin, and further in view of Tillim.

Claims 11, 14, 33, and 36 are rejected as unpatentable over Heidel in view of Tillim and further in view of Kaish.

Claims 1 and 23 are rejected as obvious over Siemens (U.S. Patent 6,659,340) in view of Heidel.

Claims 1 and 23 are rejected as unpatentable over Kobayashi et al. (U.S. Patent 6,712,219, hereinafter Kobayashi) in view of Heidel.

All of the foregoing rejections are respectfully traversed.

The Invention

There are four pending independent claims in this patent application, claims 1, 16, 23, and 38. Independent claims 1 and 23 are directed to a currency control system that includes one or more portable safes, one or more game-related devices to which a safe is removably attachable, and a currency control device to which a safe is removably attachable. The currency control device in all of the claims directed to the currency control system is located at a position remote from the game-related device or devices so that the portable safes are transported between the game-related device or devices and the currency control device. When a portable safe is attached to the game-related device, it holds currency. When a portable safe is attached to the currency control device, then currency is transported between the currency control device and the portable safe in order to provide security in accounting

for currency collected from players of a game-related device and for dispensing prizes or change to such players.

Independent claims 16 and 38 are directed to a portable safe removably attachable to a currency control device that is located remotely from a game-related device to which the portable safe is also attachable. The portable safe includes a housing for holding currency, an antenna for exchanging information wirelessly with the currency control device and a game-related device. The housing further includes two windows for insertion and discharge of currency, corresponding shutters opening and closing these windows, and a lock mechanism that locks and unlocks the shutters upon detachment from and attachment to either of a game-related device or the currency control device. The safe or safes permit transportation of currency safely and securely between the game-related device or devices and the currency control device that is remotely located relative to the game-related device or devices. In this Amendment claims 16 and 38 are amended to conform the claims more closely to each other. No other previously examined claims are amended

New Claims

New claims 45-48 describe the game-related device as a game card vending machine. These claims are supported in the patent application from page 10, line 24 through page 18, line 28 and Figure 3.

Non-Analogous Art

The Examiner replied, at pages 15 and 16 of the Office Action, as to why he concludes that Kaish and Martin are analogous art that can be applied in the obviousness rejections of the former and current Office Actions. Applicant maintains his view that neither of these two patents is analogous prior art and the application of either of the patents in the obviousness rejections is improper. The basis for this position provided in the response filed January 26 2005 is incorporated here by reference without being set out at length.

Prior Art Rejections

Claims 1 and 23, directed to the currency control system, are similar, although not identical, in claimed subject. These claims were commonly rejected. Clearly, if these two claims are allowable, then so are the claims that depend from claims 1 and 23, namely claims

2-15 and 24-37. There was no suggestion that any of the secondary references cited in the obviousness rejections supplied any parts of claims 1 and 23 but only the features of the dependent claims rejected as obvious. Therefore, the following comments focus on the rejection of claims 1 and 23. However, Applicant maintains the arguments against the prior art rejections that were presented in the response filed January 26, 2005, which are incorporated by reference, although not set out at length.

Each of claims 1 and 23 was subjected three different rejections. In the initial rejection, claims 1 and 23 were rejected as anticipated by Heidel. This rejection cannot be maintained if Heidel fails to disclose all of the elements of claims 1 and 23. Several features of claims 1 and 23 are missing from Heidel, including the remote location of the currency control device with respect to the game-related device or devices. The absence of this feature alone prevents anticipation so that the rejection must be withdrawn.

As previously pointed out, Heidel describes an apparatus, curiously referred to as a hopper 16, that is attached to a slot machine and that includes a cassette 18 that is removably attachable to the hopper. The function of the hopper is to dispense "paper tokens", i.e., paper money, to a player who wins a prize while operating the slot machine. A coin or token is inserted in a slot 26 in the slot machine 14 in order to play the machine. The function of the hopper is to dispense the currency that has been loaded into the cassette 18 as a cash prize. The cassette 18 is removable so that it can be taken to a cash loading station for the purposes of both accounting reconciliations with regard to the dispensed currency and manual reloading of currency into the cassette. Much of Heidel is directed to the mechanical structure that provides for dispensing currency from the cassette through the slot 36 in the hopper.

It is clearly impossible for Heidel to describe, in any of its elements, anything corresponding to the portable safe and the currency control device of the currency control system as defined by claims 1 and 23. Claims 1 and 23 specify that the currency control device is located at a position remote from the game-related device. No one can reasonably assert, after studying Figures 1 and 10 of Heidel, that the hopper 16 is remotely located from the Heidel slot machine 14. (The Examiner's assertion to the contrary is discussed in detail below.) Moreover, the amended claims state that the portable safe is transportable between the game-related device and the currency control device. Again, it is impossible to consider that the Heidel cassette 18 is transportable between the Heidel slot machine 14 and the hopper 16 for any useful purpose because the hopper is attached to the slot machine and the slot machine has no interaction with

the cassette 18 except through the hopper 16. Applicant agrees that the cassette 18 of Heidel is transportable between the slot machine 14 and a docking station, including a housing 100, at a remote location. However, as explained below, that housing 100 cannot correspond to the currency control device of the invention because it does not provide for either transferring currency into or out of the cassette 18.

Figure 10 is the only figure of Heidel that shows the remote location where the accounting function can take place. There, a cassette 18, retrieved from a hopper attached to a slot machine, is inserted into the housing 100 of the docking station. The docking station provides an electrical interconnection to a computer for obtaining information on the quantity of the currency dispensed, including currency that was unsuccessfully attempted to be dispensed and was retained in a separate part of the cassette.

Figure 4 of Heidel shows that in order to load the cassette 18 with currency, the hinged lid of the cassette must be opened. When the cassette 18 is inserted into the housing 100 of the docking station, it is impossible to open the cassette 18 as shown in Figure 4. In other words, it is physically impossible for the docking station, if compared to the currency control device of the present invention, to transfer currency into the cassette 18 or transfer currency out of the cassette 18 because the cassette is completely closed and cannot be opened when attached to the docking station.

In the Office Action mailed April 27, 2005, the Examiner took issue with only one of the points raised in the Response filed January 26, 2005. According to page 15 of the Office Action, the Examiner is authorized to interpret Heidel so broadly as to state that the hopper 16 and the cassette 18 are not only next to each other but, at the same time, remote from each other because they are not directly in contact with each other. In a further example of the interpretation made of the term “remote”, the Examiner asserted that if two elements are normally two inches from each other, if they are separated by an additional half percent in distance, then the elements are remote from each other. Not only are these assertions self-contradictory, they are contrary to the dictionary definitions supplied by the Examiner at page 15 of the Office Action.

According to the supplied definition, “remote” can mean “separated by an interval or a space greater than usual”. The gloss that the Examiner is placing on the word “usual” is inconsistent with the other definitions supplied as well as similar definitions of the word “remote” taken from other dictionaries. For example, the American Heritage Dictionary (1982) provides as the first definition of “remote”, “located far away, relatively distant in space”. If, in

the Examiner's example, the distance between two objects is normally two inches, no one of ordinary intelligence would conclude that a change in separation too small to be measured except by precision instruments would make two objects remote from each other.

As already acknowledged, in Heidel, the docking station 100 is clearly remote from the slot machine 14, the hopper 16, and the cassette 18, when the cassette is attached to the hopper. However, no one, contrary to the rejection, would ever describe the cassette when mounted in a hopper that is physically attached to the slot machine, as remote from the slot machine. While examiners are instructed to give claim terms broad interpretation, the precise instruction is to give claim words their "broadest *reasonable* interpretation". See MPEP 211.

"When not defined by applicant in the specification, the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art."

Here, as explained above, one need consider only the ordinary person, without regard to mechanical skill, to understand the meaning of the term "remote" and to recognize that Heidel's hopper 16, permanently affixed to the slot machine 14, cannot, in any reasonable manner, be considered to be "remote" from the slot machine. On that basis, the rejection of claims 1 and 23 as anticipated by Heidel and the rejections of claims 2-15 and 23-37 as obvious over Heidel in view of various additional references, should, upon reconsideration, be withdrawn.

In the Office Action mailed April 27, 2005, claims 1 and 23 were newly rejected as obvious over Siemens in view of Heidel. This rejection is respectfully traversed.

Siemens describes a currency receiving apparatus that receives paper money and accumulates the paper money in a canister 46 that the Examiner compared to a safe. The canister can be received in a housing 12 of the currency receiving device. The Examiner characterized the currency counter 16 of the Siemens apparatus as a currency control device "to which said portable safe is removably attachable". Clearly, the currency counter 16 is part of the Siemens apparatus into which the canister 46 can be inserted and withdrawn.

The problem with the citation of Siemens, is that ,as admitted in the Office Action, the Siemens apparatus has nothing to do with any kind of game-related device. Heidel was relied upon as supplying the game-related device, i.e., a slot machine. However, the issue is not

whether Heidel describes a game-related device, such as the slot machine 14, the question is whether there is motivation to modify Siemens with Heidel. Why would one of skill in the art modify the currency collecting apparatus of Siemens and use it in combination with the slot machine of Heidel? The Office Action, in attempting to answer this question at page 13, does not provide a response that is consistent with the disclosure of Siemens and Heidel. Obviously, the basis of the combination is hindsight reconstruction, i.e., knowledge of the invention.

According to page 13, of the Office Action, the suggestion for the modification of Siemens with Heidel is that both describe “a currency vending machine”. This statement is incorrect. Siemens describes a currency *collecting* machine that collects currency and holds the currency for subsequent deposit in a bank or like institution, while providing accounting for the deposited currency and tracking of its location until the currency reaches the bank. The currency reaches the bank when the canister 46 is withdrawn from the collecting apparatus and emptied, for example, as illustrated in Figure 6 of Siemens. There simply is no advantage or apparent reason for placing together, for example, at remote positions in the same building, the currency collecting apparatus of Siemens and the apparatus of Heidel. Perhaps the apparatus of Siemens might be placed in such a location so that winning players could deposit their winnings, in the form of currency, in a bank before leaving the facility. However, such an operation would have no relationship to the invention as defined by claims 1 and 23. Establishing *prima facie* obviousness requires some evidence in the art of record or common knowledge for combining elements of two references to suggest the invention claimed. That evidence is completely absent here. Therefore, upon reconsideration, the rejection based upon Siemens should be withdrawn.

In the other new rejection, claims 1 and 23 were rejected as obvious over Kobayashi in view of Heidel. This rejection is likewise erroneous and makes combinations for which there is no motivation, either in the prior art references or in any other reasonable source of knowledge, other than the present patent application.

Kobayashi describes an apparatus in which currency can be inserted and withdrawn and dispensed. Essentially, Kobayashi describes a change machine that receives and dispenses paper money in different denominations. Thus, an essential part of the Kobayashi apparatus is a reader that determines the value of currency supplied to the apparatus.

Applicant agrees that the Kobayashi apparatus includes “bill accommodation boxes 7 and 8” that hold paper money. The removable cassette 11 is considered by the Examiner to correspond to a portable safe and it is agreed that the cassette can be loaded with currency, inserted into the apparatus, and subsequently retrieved from the apparatus after exchange of bills within the cassette by the apparatus. The Examiner characterized the “discriminating portion 5”, an optical reader of some kind that determines the authenticity and denomination of a bill, as corresponding to the currency control device of claims 1 and 23.

Accepting, for the sake of argument, this characterization of Kobayashi, then the same question arises as in the rejection based upon Siemens. In the rejection based upon Kobayashi, Heidel was again relied upon as describing a game-related device. Then, without explanation, except to note that both Kobayashi and Heidel have currency handling features, it was asserted that it would have been obvious to make some combination of Kobayashi and Heidel and that that combination would be the invention as defined by claims 1 and 23. This assertion, without some support in either of Kobayashi or Heidel is simply inadequate to support the rejection. While both Kobayashi and Heidel do, admittedly, have features relating to the handling of paper money, making those patents analogous art, there is no apparent synergism or advantage that might be achieved by somehow extracting features of Kobayashi and applying them to Heidel, or *vice versa*.

The assertion that the problem allegedly solved by Kobayashi provides such motivation simply is not reasonable. Kobayashi emphasizes that by using the bill cassette 11, the bills stored within the bill accommodations boxes referenced, 7 and 8 can be exchanged, and replenished without opening the housing of the entire apparatus. Essentially what that feature explains is that there is no portable safe in the Kobayashi apparatus, as that term would be understood by one of skill in the art, because the bill cassette holds only a limited number of bills temporarily as compared to the bill accommodation boxes.

Merely identifying the elements of a claim within prior art publications cannot establish obviousness of the claim without motivation for combination of those elements as in the claimed invention. Here, with respect to both of the new rejections, based upon Siemens and Kobayashi, motivation is lacking for the purported combinations and modifications. Only hindsight, i.e., knowledge of the claimed invention, could provide that motivation. However, the patent application cannot legally be relied upon as a source of motivation.

Thus, the new rejections are legally deficient and, upon reconsideration, should be withdrawn.

The other pending independent claims, claims 16 and 38, are directed to a portable safe. As best understood, these claims are both rejected as obvious over Heidel in view Kaish and further in view of Martin. If these claims are not obvious, based upon that combination, none of their dependent claims 17-22 and 39-44 can be obvious. Therefore, the following comments are directed to those two independent claims 16 and 38 with the understanding that it is not necessary to discuss the rejections of the dependent claims. In any event, since it appears the rejection of the dependent claims have not changed, the traversal of those rejections presented in the response filed January 26, 2005 are maintained and incorporated here by reference without being repeated in detail.

Assuming, for the sake of argument, that Kaish and Martin are analogous prior art, *prima facie* obviousness of claims 16 and 38 has not been demonstrated. Among the features of the portable safe described in claims 16 and 38 are the presence of the currency insertion window section and the currency discharging window section. Further, each of these sections includes a respective shutter plate closing the window sections. The Examiner acknowledged that Martin, directed to counting coins, only describes a single gate 17, which the Examiner analogizes to the shutter for the currency inserting window section of claims 16 and 38. According to the Office Action at page 9, once the presence of one such shutter plate is known, it would have been obvious to provide a second such plate for a currency discharging window section. Of course, this statement is incorrect because it is unsupported by Martin. No such second gate is present in Martin because no second shutter gate is needed by Martin. Instead, the coins are collected in a hopper and removed in lots, not through a window or a slot, such as the entrance slot including the gate 17 in Martin. The basis for the rejection is speculation that is not supported by any mechanical element that is either present, suggested, or needed in Martin. Thus, if Martin is analogous art, *prima facie* obviousness of claims 16 and 38 has not been established.

On the same ground, even if an actuating device for the gate 17 in Martin could be considered a lock that can be enabled or disabled, Martin never describes the operation of such a lock in response to the attachment of a portable safe to another device, such as a game-related device or a currency control device. The assertion to the contrary at pages 9 and 10 of the Office Action is incorrect. According to the Office Action at page 10, a passage at column 9 of Martin

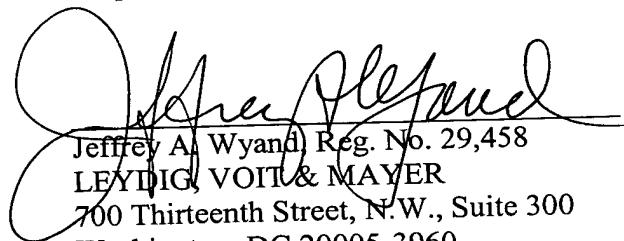
provides a basis for this rejection because it mentions that the gate may be controlled to open or close “for a number of purposes”. Examples of such “purposes” are described in Martin (but not in the Official Action) and they include the presence of a jam of coins, or the presence of a collection of coins in the trommel or in the coin pick-up assembly. None of these examples relates to detaching of any part of a Martin coin mechanism from any other structure, as in the invention, or the consequent closing of any gate. The passage of Martin does not support the proposition for which it was cited. Thus, at least two important features of claims 16 and 38 are entirely missing from Martin, assuming that Martin can even be considered analogous art that could be applied in an obviousness rejection. Those features are multiple window sections and respective locking shutter plates, and actuation of the lock upon attachment and detachment of two separately functioning units. Without those features being present somewhere in the references applied in rejecting claims 16 and 38, *prima facie* obviousness has not been demonstrated. Therefore, upon reconsideration, claims 16 and 38, as well as their dependent claims 17-22 and 39-44 should be allowed.

In addition, new claims 45-48 should be allowed, regardless of any other action. Only Heidel has even a tenuous relationship to the new claims. Heidel’s apparatus does not vend any game cards, it pays out currency, i.e., paper tokens, when a game player wins. Heidel’s apparatus does not receive money and supply something in exchange. Rather, Heidel’s apparatus dispenses money based on occurrence of a random event. Therefore, neither of Heidel’s hopper nor cassette suggests the game card vending machine of claims 45-48.

Conclusion

The foregoing remarks demonstrate that every pending claim is patentable over the rejections made in the Office Action mailed April 27, 2005. Accordingly, claims 1-44, all of the pending claims, should now be allowed. Only two of the forty-four previously examined claims have been amended. Therefore, should some or all of the claims not be allowed, it would not be proper to make any new rejection, based upon newly applied publications or a different legal ground, a final rejection.

Respectfully submitted,



Jeffrey A. Wyand Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: July 14, 2005
JAW:yes

Amendment or ROA - Regular (Revised 5-19-05)